



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/222,336	12/28/98	STORY G	02541.P009

LMC1/1027  
BLAKELY SOKOLOFF TAYLOR & ZAFMAN  
12400 WILSHIRE BOULEVARD  
7TH FLOOR  
LOS ANGELES CA 90025

EXAMINER  
LEE, C

ART UNIT	PAPER NUMBER
2764	5

DATE MAILED: 10/27/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/222,336**

Applicant(s)

**Story et al**

Examiner

**Chinor M. Lee**

Group Art Unit  
**2764**



☒ Responsive to communication(s) filed on Dec 28, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 2, 4, 6-9, 11, 12, 14, 16-19, 21, and 22 is/are rejected.

☒ Claim(s) 3, 5, 10, 13, 15, 20, and 23 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to because improper margins, letters, numbers, etc. Correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1, 7, 8, 11, 12, and 21 are rejected under 35 U.S.C. 102(a) as being anticipated by Cooper et al (5,757,907).
4. As per claim 1, it is disclosed in Cooper et al a system in which a license having a first cardinality is created by a license management device, storage of the first license in which the set of playback devices is determined, in part, by the first cardinality and authorization of playback is granted (abstract and columns 1-2).
5. Claim 7 is rejected as stated above in claim 1 and it is further noted that the playback device be a hardware playback device is an inherent feature.
6. Claim 8 is rejected as stated above in claim 1 and it is further noted that the playback device be a software playback device is an inherent feature.

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7. Claim 11 is rejected as stated above in claim 1.

8. As per claim 12, it is disclosed in Cooper et al a system which processors to execute the instructions (columns 1-2).

9. Claim 21 is rejected as stated above in claim 1.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2, 4, 6, 14, 16, 17, 18, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al (5,757,907) and Wyman (5,745,879).

12. As per claim 2, it is not disclosed in Cooper et al a system in which a license is stored in multiple contents, yet it is disclosed in Wyman (column 6).

13. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention to combine the license management system of Cooper et al with the system of Wyman which allows for the storage of licenses in multiple contents thereby allowing the user the ability to flexibility to playback several different media types.

14. As per claim 4, official notice is taken that it is well known in the software license management arts that the cardinality may be either fixed or unlimited much in the same way that software, or shareware, is previewed for a certain amount of instances or when software is

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purchased the access to it is normally unlimited. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to make the cardinality either fixed or unlimited to provide flexibility to the system.

15. Claim 6 is rejected as stated above in claim 4.
16. Claim 14 is rejected as stated above in claim 4.
17. Claim 16 is rejected as stated above in claim 4.
18. Claim 17 is rejected as stated above in claim 7.
19. Claim 18 is rejected as stated above in claim 8.
20. Claim 22 is rejected as stated above in claim 12.
21. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper et al and Wyman as applied to claim 2 above, and further in view of Griswold (5,940,504).
22. As per claim 9, it is not disclosed in Cooper et al or Wyman a system in which the digital content is audio programming, yet it is disclosed in Griswold (columns 1-2).
23. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to combine the license management systems of Cooper et al and Wyman with the license protection system of Griswold, to add protection to such easily copied mediums.
24. Claim 19 is rejected as stated above in claim 9.

***Allowable Subject Matter***

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25. Claims 3, 5, 10, 13, 15, 20, and 23 are objected to as being dependent upon a rejected base claim, but may be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-Dunham et al (4,791,565) teaches an apparatus for controlling the use of computer software.

-Robert et al (4,937,863) teaches a software licensing management system.

-Olsen (5,758,069) teaches an electronic licensing system.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chinor M. Lee whose telephone number is (703) 306-5446. The examiner can normally be reached on Monday-Thursday from 7:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

Any response to this office action should be mailed to:

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

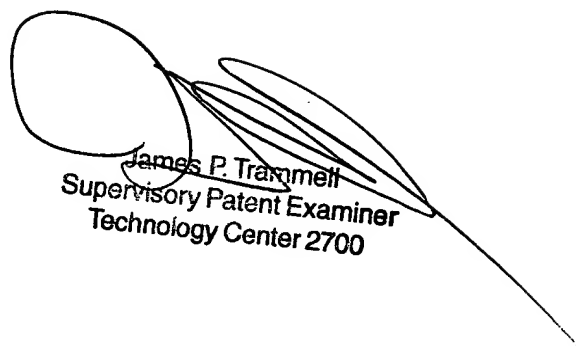
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CML

October 25, 1999



James P. Traxmell  
Supervisory Patent Examiner  
Technology Center 2700